



#13/Petition

S/N 10/004,623

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BURFEIND ET AL. Examiner: Taylor, Victor J.  
Serial No.: 10/004,623 Group Art Unit: 2863  
Filed: December 3, 2001 Docket No.: 14305.6USC1  
Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA  
NATURAL PHENOMENOLOGICAL INFORMATION

## CERTIFICATE UNDER 37 CFR 1.10

'Express Mail' mailing label number: EV322887254US

Date of Deposit: December 23, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 on the date indicated above and is addressed to the Mail Stop Petition, Commissioner of Patents and Trademarks, Alexandria, Virginia 22313-1450

By:

Name: Teresa Anderson

PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL OF HOLDING OF  
ABANDONMENT

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Dear Sir:

This petition, filed under 37 CFR §1.181, seeks withdrawal of a holding of abandonment in the above-identified case. Applicants were made aware of the abandonment via a Notice of Abandonment mailed on October 1, 2003. This petition requires no fee. MPEP §711.03(c). If the Examiner believes that a fee is due, please charge Deposit Account No. 13-2725.

On February 4, 2003, a terminal disclaimer was filed that dedicated to the public a terminal part of the term of any patent granted in the above-captioned case that would extend beyond the date 20 years from the filing of the parent application, U.S. Patent Application No. 09/374,168, filed on August 13, 1999, now U.S. Patent 6,360,172 B1, issued March 19, 2002.

### Statement of Facts

The above-identified application was filed by the Applicant on December 3, 2001, via legal counsel at Schwegman, Lundberg, Woessner & Kluth ("Schwegman"). See Johns Declaration, ¶ 3. This application is assigned to Digital Cyclone, Inc. ("Digital Cyclone"). Id. Digital Cyclone holds several related patent applications in the field of personalized multimedia.

On February 28, 2003, Digital Cyclone transferred all of its files from Schwegman to Merchant & Gould, where this case is now being prosecuted. See Johns Declaration, ¶ 4. On March 10, 2003, papers were filed with the U.S.P.T.O. granting Merchant & Gould power of attorney in this matter, and directing future correspondence to Merchant & Gould. See Johns Declaration, ¶ 5. Fourteen days later, on March 24, 2003, a first Office Action was mailed. See Johns Declaration, ¶ 6. Unfortunately, this Office Action was mailed to Schwegman, Applicant's previous legal representative. Id. Schwegman took steps to notify Applicant of the Office Action, and eventually the Office Action was received by Merchant & Gould. See Johns Declaration, ¶ 7.

At Merchant & Gould, correspondence from the U.S.P.T.O. is routed through a docketing department and is entered into a computerized docketing system to ensure timely response. See Johns Declaration, ¶ 8. Because the Office Action was forwarded to Merchant & Gould through an intermediary, it was not identified as correspondence from the U.S.P.T.O., and was never entered into the docketing system. See Johns Declaration, ¶ 9. For this reason, Applicant unintentionally failed to respond to the Office Action within the permissible six-month period. Id.

Upon transfer of Digital Cyclone's files to Merchant & Gould in February 2003, Richard Gregson was assigned to prosecute this application. See Gregson Declaration, ¶ 2. Mr. Gregson prosecuted this application until his departure from Merchant & Gould on September 30, 2003. Id.

On July 9, 2003, Mr. Gregson conducted a telephone interview with the Examiner assigned to this application. See Gregson Declaration, ¶ 3. According to an Interview Summary mailed with the Notice of Abandonment, Mr. Gregson "indicated that the applicant would not respond and that the case was abandoned." In fact, Mr. Gregson made no such statement. See Gregson Declaration, ¶ 3-5.

According to Mr. Gregson, the topic of how the Applicant might respond to the Office Action came up during the telephone interview. See Gregson Declaration, ¶ 4. Mr. Gregson told the Examiner that he would have to discuss this matter with the client, because the client held several related patent applications, and the response in the present case needed to be determined in light of issues in the other applications. See Gregson Declaration, ¶ 4. At no point did Mr. Gregson state or suggest that the client intended to abandon the application or fail to respond to the Office Action. See Gregson Declaration, ¶ 5.

### Remarks

#### The Holding of Abandonment Should be Withdrawn Because Notice Was Sent To The Incorrect Address

Applicant's counsel respectfully submits that the holding of abandonment should be withdrawn because the United States Patent and Trademark Office failed to mail the Office Action in question to the correct address. This failure comes in the wake of Applicant's counsel having instructed the U.S.P.T.O. to address future correspondence to Merchant & Gould.

Had the U.S.P.T.O. correctly addressed the Office Action, it would have been docketed, and timely response would have been provided. Instead, Merchant & Gould received the Office Action through informal means, and the Office Action was never docketed. For this reason, at the time the Notice of Abandonment was received, a search of the file jacket and docket records indicate that the Office Action was never received from the U.S.P.T.O. See Johns Declaration, ¶ 10. A copy of the docket record where the Office Action would have been entered and docketed is enclosed herewith. See Declaration of Jodi Gandel-Klein in Support of Petition to Withdraw Holding of Abandonment, ¶¶ 1-7.

#### Mr. Gregson Did Not Expressly Abandon This Application

The Applicant's counsel respectfully points out that the Interview Summary makes reference to an event that occurred on September 26, 2003, meaning that the Interview Summary was written no earlier than that date. Thus, the Interview Summary was written nearly three months after the telephone interview was conducted. The passage of time may have caused the Examiner to forget the exact substance of the telephone interview.

The Applicant's counsel respectfully makes the following observations. On September 25, 2003, representatives from Digital Cyclone and attorneys from Merchant & Gould (including Mr. Gregson) met to discuss strategy. See Johns Declaration, ¶¶ 11-13. During that meeting, this application was discussed. Id. This application figures prominently in Digital Cyclone's strategy. Id. At no point in time did the topic of this case having been abandoned, or at risk of being abandoned, ever arise. Id. It is unthinkable that the topic of abandonment of this case would not have arisen if Mr. Gregson had been aware that this case was abandoned or at risk of being abandoned. Moreover, at the time of the telephone interview, more than two months of extendable time in which to respond to the Office Action remained. There would have been no reason for Mr. Gregson to expressly abandon the application at such a time.

This Petition Has Not Been Intentionally Delayed

The MPEP indicates that this petition may be dismissed "where the record indicates that the applicant intentionally delayed in filing the petition." See MPEP 711.03(c). As mentioned above, the Merchant & Gould attorney originally assigned to prosecute this case left Merchant & Gould on September 30, 2003, one day prior to the mailing of the Notice of Abandonment. The period of time between receipt of the Notice of Abandonment and the present has been spent investigating this matter and determining the appropriate manner in which to proceed—a task made difficult due to the departure of the aforementioned attorney. The applicant has not intentionally delayed in filing this petition.

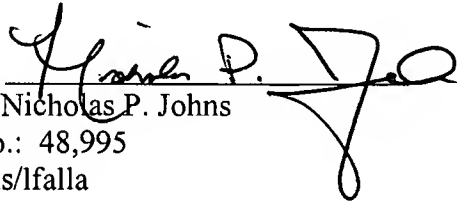
Conclusion

Applicants respectfully petition for withdraw of the holding of abandonment of the above-captioned application. Applicants thank the Commissioner for consideration of this matter. Should any further input be required to resolve this matter, the Commissioner is urged to contact the undersigned by telephone at the number below to expeditiously bring this matter to a close. Should any fees be required for the filing of this Petition, please charge Deposit Account No. 13-2725

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612.332.5300

Dated: 23 Dec 2003

Signed:   
Name: Nicholas P. Johns  
Reg. No.: 48,995  
NPJohns/lfalla